

Gupta et al.

S/N: 09/747,647

REMARKS

Claims 1-21 are pending in the present application. In the Office Action mailed October 8, 2003, the Examiner rejected claims 1-21 under 35 U.S.C. §103(a) as being unpatentable over Martin et al. (USP 5,809,479) in view of Schoenberg et al. (USP 6,322,502). The Examiner objected to the specification stating that "on page 6, line 15 'Internet' before 'server 12' should be replaced with -Intranet-."

Applicant has amended paragraph 19 of the specification to correct the typographical error. Applicant appreciates the thorough review of the application.

The Examiner rejected claims 1-21 under 35 U.S.C. §103(a) over Martin et al. in view of Schoenberg et al. Pstating that "Martin et al. discloses a method of reporting status of work in progress, comprising the steps of periodically querying a database that contains order data and comparing the data and a request data" and that "Schoenberg et al. discloses a database monitoring function that allows a user to be alerted when an order is late." Citations omitted. Applicant respectfully disagrees. Furthermore, the Examiner took Official Notice "that proactive and reactive altering systems are well known in the art." Therefore, the Examiner took Official Notice twice. That is, the Examiner took Official Notice that proactive alerts are well known and that reactive alerts are well known. The Examiner's use of Official Notice is hereby traversed and is improper under the MPEP.

Official Notice Inappropriate Under MPEP §2144.03

"The Examiner may take Official Notice of facts outside of the record which are capable of instant and unquestionable demonstration as being 'well-known' in the art." MPEP §2144.03. However, MPEP §2144.03 is clear that "such rejections [relying on Official Notice] should be judiciously applied," be "rare," and be used "[i]n limited circumstances." Nevertheless, as shown above, the current Office Action included two instances of Official Notice, i.e., that proactive alerts are well known and that reactive alerts are well known.

Furthermore, "any facts so noticed should be of notorious character and serve only to 'fill in the gaps' in an insubstantial manner which might exist in the evidentiary showing made by the Examiner to support a particular ground for rejection." MPEP §2144.03. Applicant does not believe that the Examiner's use of Official Notice is merely to "fill in the gaps." That is, proactive alerts are an integral element of the claimed invention in that the claimed method and apparatus for reporting the status of work in progress fundamentally includes such alerts. Therefore, it is apparent that proactive alters are far from an ancillary "gap" that the Examiner is

Gupta et al.

S/N: 09/747,647

attempting to "fill." Rather, the Examiner is reaching far beyond the scope of appropriate use of Official Notice.

The Examiner's application of Official Notice is particularly inappropriate when coupled with the Examiner's conclusion that "a person of ordinary skill in the art would recognize that alerting systems can be programmed as either proactive or reactive as desired by the user." That is, in the current Office Action, the Examiner effectively took a first Official Notice that (1) proactive alerts are well known, (2) reactive alerts are well known, and (3) alerting systems can be programmed as either proactive or reactive as desired by the user. Therefore, in a single Action, the Examiner effectively took three Official Notices. This is clearly improper under MPEP §2144.03.

Official Notice Traversed

The Examiner must "cite a reference in support of his or her position" should the Applicant traverse the assertion. MPEP §2144.03. Applicant hereby traverses the assertion. Furthermore, "[i]t is never appropriate to rely solely on 'common knowledge' in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based." MPEP §2144.03 citing *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). In the current rejection, the Examiner has not shown that "proactive and reactive alerts" were "well known" in the context of methods and apparatuses for reporting status of work in progress at the time the invention was made. "The requirement 'at the time the invention was made' is to avoid impermissible hindsight." MPEP §2141.01. Nevertheless, Applicant believes the Examiner's Official Notice is clearly an application of impermissible hindsight.

For all of the above reasons, Applicant believes the Examiner's use of Official Notice is improper and is thereby traversed. Should the Examiner persist on the current basis for rejection, the Examiner is required to provide affirmative support for all three uses of Official Notice. In the absence of such affirmative support, no sustainable basis for rejection remains and claims 1-21 should be deemed to be in condition for allowance.

Failure To Establish A Prima Facie Case Of Obviousness

The impropriety of the Examiner's use of Official Notice notwithstanding, the Examiner has failed to establish a *prima facie* case of obviousness. The burden of establishing a *prima facie* case of obviousness falls on the Examiner. MPEP §2142. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933

Gupta et al.

S/N: 09/747,647

(Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes each and every element of the claimed invention, but also provide "a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). That is, "[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." MPEP §2143.01. "The fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness." *Id.* (Emphasis added) When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988).

With respect to the case at hand, as the title of Martin et al. reflects, the system disclosed therein is related to tracking and reporting on-time delivery data. Simply, the system disclosed therein is configured to generate a report from database information. The system of Martin et al. does not report status of work in progress; rather the system reports the status of completed work. "The invention helps a supplier set targeted delivery dates and goals within each customer's expectations, while also providing a statistical analysis of on-time deliveries in accordance with each customer's own evaluation preferences." Col. 2, lns. 9-14. Such a system is reactive in nature. The present invention is proactive, setting forth a system which anticipates a possible late delivery before it occurs and solves the problem of late deliveries rather than maintaining after-the-fact delivery data. Simply put, the invention solves, rather than merely identifies, the problem of late deliveries.

Martin et al. states that "database maintenance is typically performed by customer service representatives of the supplier, from within the suppliers order processing computer system." Col. 2, lns. 43-47 (emphasis added). Martin et al. further states that "...the computer system is programmed to show the order scheduler the calculated customer-preferred ship date and to obtain from the scheduler a targeted ship date for the customer order entry." (Emphasis added) Col. 3, lns. 63-67. That is, the system of Martin et al. is reactive to scheduler inputs, not proactive to delivery problems as is specifically called for in claim 1, for example. The system of

Gupta et al.

S/N: 09/747,647

Martin et al. "...is programmed in a step 30 to generate on-time product delivery statistics for individual customers." Col. 4, lns. 54-57. That is, the system does not report the status of work in progress but reports the status of completed work. As shown in the chart in Col. 5 of Martin et al., the system generates an on-time shipping report. That is, the work is already completed and is either late or on time. Such a system is reactive to delivery difficulties rather than proactive to overcome processing considerations to directly improve delivery performance -- in real time. See claim 5. Martin et al. states that "The system and program described above allow a supplier to easily measure its performance using the same evaluation criteria used by its customers." (Emphasis added) Col. 5, lns. 47-49. In other words, the work needs to be completed in order to measure the performance. As such, the system of Martin et al. does not teach, or even suggest, monitoring the status of work in progress as the customer is only interested in delivery -- or work that is already completed.

Additionally, because Martin et al. is interested in after completion report generating, there would be no motivation to combine the system of Martin et al. with any alerting function that may be disclosed in Schoenberg et al. In light of the art of record, applicant has amended claim 1 to no longer require displaying the proactive promise alerts by product category and type of alert. The art of record does not display a proactive alert if a promise date is later than a request date. As such, for at least the reasons set forth above, claim 1, and those claims that depend therefrom, are patentably distinct over the art of record. The subject matter removed to broaden claim 1 has been added to claim 4.

Claim 9 calls for a computer-readable medium having stored thereon one or more computer programs that, when executed by one or more computer programs, causes the one or more computers to, in part, populate a database and periodically query the database. As disclosed in Martin et al., it is not the system of Martin et al. that populates the database but a plurality of user inputs. Similarly claim 16 calls for a computer data signal representing a sequence of instructions that, when executed by one or more processors, causes the one or more processors to, in part, populate a database and query the database to compare the data stored therein. As stated above, it is not the system of Martin et al. that populates the database but a plurality of user inputs. Martin et al. is not the automated proactive system as claimed. As such, that which is called for in claims 9 and 16, and those claims that depend therefrom, are patentably distinct over the art of record.

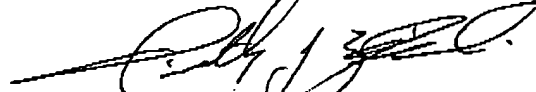
Therefore, in light of the foregoing, Applicant respectfully believes that the present application is in condition for allowance. As a result, Applicant respectfully requests timely issuance of a Notice of Allowance for claims 1-21.

Gupta et al.

S/N: 09/747,647

Applicant appreciates the Examiner's consideration of these Amendments and Remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved.

Respectfully submitted,



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